



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/506,472 | 04/06/2005 | Jeremy Marshall | 3003-1153 | 8915 |

466 7590 08/23/2006

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

| |
|----------|
| EXAMINER |
|----------|

GILBERT, ANDREW M

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3767

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/506,472 | Applicant(s) MARSHALL ET AL. | |
| | Examiner Andrew M. Gilbert | Art Unit 3767 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This office action is in response to the reply filed on 8/3/2006.
2. In the reply, the Applicant amended claim 1 to recite claim language believed by the Applicant to overcome the objection to the drawings. It is not persuasive. The drawings still fail to show sequential operation, a slidable collar, and a second spring meanwhile serving to retain the syringe seated at its forward position. In essence, the drawings fail to show and feature the Applicant's claimed invention. The objection is maintained.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the spring drive being operable sequentially to urge a syringe within the housing forwards to project its needle from the forward end of the housing and then to press a piston within the syringe forwards to eject a dose through the needle; a second spring meanwhile serving to retain the syringe seated at its forward position; the collar being slidable lengthwise within limits must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

Art Unit: 3767

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 recites the limitation "its forward position" in ln 11 and 15. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recited the limitations "the second spring meanwhile serving to retain the syringe seated at its forward position." The Examiner is unclear as to the meaning of "forward position" in claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bergens et al (6270479). Bergens et al discloses an injection device (Fig 1A-D) having a housing (Figs 1A-D) with a spring drive operable sequentially firstly to urge a syringe within the housing forwards to project its needle from the forward end of the housing (Figs 1A-D) and then to press a piston within the syringe forwards to eject a dose through the needle (Figs 1A-D; col 11, lns 44-col 13, ln 19); wherein the spring drive includes a first spring (140) that acts between the housing and a plunger aligned to cooperate with a piston (Figs 1A-D; col 11, lns 44-col 13, ln 19), and a second spring (156) that acts between the plunger and the syringe, the second spring being weaker than the first spring but being sufficiently stiff to be in an expanded state when the syringe reaches its forward position with its needle penetrating the flesh of a patient (Figs 1A-D; col 11, lns 44-col 13, ln 19), whereupon the first spring, as it fully expands, will then compress the second spring to urge the plunger forwards and thereby move the piston and expel the dose within the syringe (Figs 1A-D; col 11, lns 44-col 13, ln 19), the second spring meanwhile serving to retain the syringe seated at its forward position (Figs 1A-D; col 11, lns 44-col 13, ln 19); wherein the plunger has a collar (153) slidable lengthwise within limits (Figs 1A-D; col 11, lns 44-col 13, ln 19), and the second spring

Art Unit: 3767

bears on the rear side of this collar while the forward side of the collar co-operated with the syringe (Figs 1A-D; col 11, lns 44-col 13, ln 19); including a third, light spring (134) urging the syringe rearwardly so that its needle is retracted within the housing prior to use (Figs 1A-D; col 11, lns 44-col 13, ln 19); and the third spring encircles the syringe and acts between a rear flange of the syringe and an internal shoulder of the housing (Figs 1A-D; col 11, lns 44-col 13, ln 19).

Response to Arguments

Applicant's arguments, see Remarks, filed 8/3/2006, with respect to the rejection(s) of claim(s) 1-4, 7-8 under Sinclair et al have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bergens et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jordan et al (4858607); Duchon et al (5879311).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

